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Mailed : 12-14-06

In re Application of : DECISION
James M. Sheppard, Jr. : GRANTING
Serial No. 09/837,094 : PETITION
Filed: April 18, 2001 :
For: JACQUARD OR DOBBY WOVEN TEXTILE WITH :
GRAPHIC IMPRESSION AND A METHOD :
OF MAKING THE SAME :
:

This is a decision on the November 22, 2006, "Petition Under 37 CFR 1.181" requesting withdrawal of the dismissal of the appeal and resulting abandonment of the instant application.

The petition is before the Director of Technology Center 1700 for consideration.

The petition is **GRANTED** for the reasons below.

BACKGROUND

An appeal brief was first filed on May 15, 2006, and held to be non-compliant under 37 CFR 41.37(c)(1)(v). The examiner deemed the "Summary of claimed subject matter" to be non-compliant for failing to be limited to the claimed subject matter and for failing to identify where each claimed feature is located in the specification.

Applicant responded with an amended appeal brief on August 3, 2006. Applicant declined to remove the subject matter objected to by the examiner from the summary, but did provide reference to a table provided as an attachment to the brief which mapped the claims against the specification.

The examiner held the amended brief to be non-compliant, again for not being limited to the claimed subject matter, and additionally because the table was not located within the summary. The examiner then dismissed the appeal under 37 CFR 41.37(d), and abandoned the application on November 7, 2006.

The instant petition was timely filed on November 22, 2006.

DECISION

The relevant sections of 37 CFR 41.37(c) read as follows:

(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The original appeal brief was held non-compliant for two related reasons which will be considered separately here. The first was that the summary was not limited to the claimed subject matter, but instead was related “to general information in the disclosure.” In and of itself, this is generally not a proper reason to hold an appeal brief non-compliant. As noted in the Federal Register (Vol. 69, No. 155) when the current rules were published “[a]ppellant may include any other information of record which will aid the Board in considering the subject matter of each independent claim.” Further, 37 CFR 41.37(c)(1)(v) does not specifically prohibit inclusion of additional material in addition to the concise explanation. So long as the summary contains a readily discernable concise explanation it may contain other information. Therefore, neither the original brief nor the amended brief can be properly deemed non-compliant for not being limited to the claimed subject matter.

The original brief was further held non-compliant for failing to identify where each claimed feature is located in the specification. As 37 CFR 41.37(c)(1)(v) requires an explanation of the independent claims with reference “to the specification by page and line number” this ground of non-compliance was appropriate. Applicant appears to have conceded this point by inclusion of the table.

Thus the original brief, particularly the summary, was properly held non-compliant only for failing to identify where the claimed features are located in the specification. The question then becomes whether the amended brief sufficiently corrects this deficiency.

The examiner held the amended brief non-compliant for not being limited to the claims and because the table was not located within the summary itself but rather as an attachment. As noted above, the inclusion of general background information is insufficient to render a summary non-compliant.

As to the location of the table, applicant argues in the petition that “the rule does not prohibit reference in this section of an appeal brief to a table that is physically located at a different place in the appeal brief.” This is incorrect. 37 CFR 41.37(c) states “the brief shall contain the following items under appropriate headings and in the order indicated.” A fair reading of the rule implies that the information required by each item must be physically located “under appropriate heading” and not elsewhere in the brief as it would then not be “in the order indicated.”

Therefore the examiner was correct in holding the amended brief non-compliant only because the table was not located within the summary itself.

The question of the propriety of the abandonment must therefore be considered. 37 CFR 41.37(d) states:

If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Thus abandonment is appropriate upon filing a second non-compliant brief only if the second brief is non-compliant for reason(s) “stated in the notification,” i.e., for the same reason(s) as the first brief. In the instant case the reason stated in the first notification was failing to identify where each claimed feature is located in the specification. Arguably, the amended brief is non-compliant for the reason stated in the notice, that is for failing to identify where each claimed feature is located in the specification. However, the failure in the first instance was a complete *lack* of such information, whereas the failure in the second instance was *misplacement* of the required information. It is equally arguable that this is *not* exactly the reason “stated in the notification.”

As a matter of equity, the Office will not hold an application abandoned for failure to comply with a rule without first giving applicant a fair opportunity to so comply upon proper notice of the Office’s interpretation of that rule. Here, applicant was first clearly informed that the provided table was misplaced along with the notice of abandonment, and hence had no opportunity to correct the problem. Abandonment of the application in such circumstances is inappropriate.

It is noted that the instant petition was filed along with a revised summary of claimed subject matter which incorporates the table and which satisfies the rules. Accordingly, the petition for withdrawal of abandonment and reinstatement of appeal is GRANTED. The application is hereby returned to pending status. An appeal brief has been timely filed in this application, therefore the case is being forwarded to the Examiner for treatment of the amended appeal brief of 08/03/06 and amended summary of the claimed subject matter of 11/22/06.

JMS/face

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

DOUGHERTY, CLEMENTS & HOFER
GREGORY N. CLEMENTS
1901 ROXBOROUGH ROAD
CHARLOTTE NC 28211